

PATENT  
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the Application of:  
HELMUT HONIG ET AL.

APPLICATION NO.: 09/700443  
(PCT/EP99/02947)



CASE NO.: FA-973

GROUP ART UNIT: UNKNOWN

FILED: 30 APRIL 1999

EXAMINER: UNKNOWN

FOR: ELECTRO-DIPCOATING BATHS WITH  
ADDITIVES PREVENTING THE  
FORMATION OF CRATERS IN THE BAKED  
COATING

RECEIVED  
23 JAN 2001  
Legal Staff  
International Division

**PETITION UNDER 37 CFR §1.10(d) OR, IN  
THE ALTERNATIVE, UNDER 37 CFR §1.137(b)**

Assistant Commissioner for Patents  
Box PCT  
Washington, D.C. 20231

Sir:

This is in response to a Notice of Abandonment mailed in connection with the above-captioned application on December 7, 2000 and received on December 14, 2000 (copy enclosed). For the reasons set forth below, Applicants submit that the abandonment of the application was in error because it was based on an error of the US Postal Service. At the very least, Applicants submit that the abandonment of the application was unintentional.

This case was filed via PCT in the European Patent Office on 30 April 1999, claiming priority to an Austrian application filed 8 May 1998. Pursuant to 37 CFR §1.495(b)(2), Applicants were required to pay the basic national filing fee within 30 months from the priority date (i.e., November 8, 2000). On November 8, 2000, Applicants submitted, *inter alia*, PTO Form 1390 which authorized the Commissioner to charge Applicants' Deposit Account in the amount of the fee then due (i.e., \$1,210). The PTO Form 1390 and other documents were submitted to the USPTO using the Express Mail Post Office to Addressee procedure under 37 CFR §1.10. Applicants' Deposit Account was in fact debited for the application filing fees on November 20, 2000 and the fees have in fact been paid.

Under 37 CFR §1.10, the date of filing in the USPTO is deemed to be the date of deposit with the US Postal Service ("USPS"). The date of deposit with the USPS is deemed to be the "date-in" date reflected on the Express Mail receipt. Applicant deposited the PTO Form 1390 and other documents necessary to enter the national stage in the US with the USPS on November 8, 2000. However, the "date-in" date entered on the Express Mail label (Label No. EL031052691US) is November 9, 2000. A copy of Express Mail Label No. EL031052691US is enclosed. Applicant submits that the "date-in" date on the Express mail label is incorrect. The correct date should have been November 8, 2000.

As evidence that the "date-in" date of November 9, 2000 is incorrect, and should have been November 8, 2000, Applicant submits the following:

- ◆ Applicant maintains daily logs which are used to record all outgoing mail to the USPTO on any particular day. A separate daily log is maintained for mail relating to PCT application. The daily log sheet for November 8, 2000 (copy enclosed) reflects only one PCT related outgoing mail item - specifically the national application papers for the present case (Attorney Docket FA-0973, Appln. No. EP99/02947). The November 8, 2000 daily log sheet also reflects payment of the fee of \$1,210. No daily log sheet exists for November 9, 2000, which means that no PCT related mail was sent to the USPTO on that day.
- ◆ Applicant maintains a computer database of its patents and patent applications. That database is used to record pertinent information regarding pending applications or issued patents. It is Applicant's practice to record the filing date in the database based on the date of mailing the application papers to the USPTO under the Express Mail procedure. The relevant screen for this application (copy enclosed) shows that the date of November 8, 2000 was entered as the filing date. Consistent with Applicant's internal practice, that is evidence that the application papers were deposited with the USPS for delivery under the Express mail procedure on that date - November 8, 2000.
- ◆ The Post Card receipt that Applicant forwarded on November 8, 2000 indicates receipt by the USPTO of the national application papers, including the Form PTO 1390, on November 9, 2000. Express Mail Label EL031052691US indicates that the USPS received the application papers on November 9, 2000 for delivery the next day (i.e., November 10, 2000) by 12 Noon. Thus, either one must accept that the USPS was able to deliver the application papers to the USPTO on the day of receipt, or must accept that the "date-in" date is incorrect or the USPTO date stamp is incorrect. Applicant is not aware of any evidence to support the notion that the USPTO date stamp is incorrect. Indeed, receipt by the USPTO is consistent with the internal records of Applicant discussed above. Further, while it is not impossible that the USPS received the papers in Wilmington, Delaware and delivered them to the USPTO in Washington, D.C. on the same day, Applicant submits that it would be extremely unlikely that the USPS was able to do so and it is, of course, inconsistent with the USPS practice of next day delivery. Rather, if the papers were indeed delivered the day following receipt by the USPS (as is the practice for Express Mail) and were in fact delivered to the USPTO on November 9, 2000, then the papers must have been deposited with the USPS on November 8, 2000.

For the above reasons, Applicant submits that the USPS erroneously recorded the "date-in" date on Express Mail Label No. EL031052691US as November 9, 2000 when in fact the deposit date was November 8, 2000. Therefore, Applicant requests that the fees required by 37 CFR §1.495(b)(2) be considered as timely filed.

At the very least, Applicant submits that the above remarks and evidence clearly indicates that any abandonment of the application was unintentional and that Applicant made a diligent effort to file the application and pay the requisite fees in a timely manner. Accordingly, Applicant requests that the application be revived as having been unintentionally abandoned. The delay between the receipt of the Notification of Abandonment on December 14, 2000 and the filing of this petition, in addition to the intervening holidays, was occasioned by the need to review the facts, identify and collect the necessary evidence and prepare this petition.

The Commissioner is authorized to charge Deposit Account No. 04-1928 in the amount of \$130, the petition fee set forth in 37 CFR §1.17(h), which is believed to be applicable to petitions filed under 37 CFR §1.10(d). In the event that the Office deems this to be a Petition under 37 CFR 1.137(b), the Commissioner is authorized to charge the Deposit Account in the amount of \$1,210, the petition fee set forth in 37 CFR §1.17(m)(2). Should these amount be insufficient or excessive, the Commissioner is authorized to charge or credit Deposit Account 04-1928 accordingly.

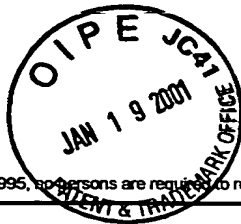
Respectfully submitted,



Joseph A. Tessari  
Attorney for Applicants  
Registration No. 32,177  
Telephone: 302-892-7916  
Facsimile: 302-992-2533

Dated: January 16, 2001

Enclosures: Notification of Abandonment, mailed 12/07/00  
Express Mail Label No. EL031052691US  
Daily Log Sheet for November 8, 2000  
Database Screen Shot  
Stamped Post Card Receipt



3 Rec'd PCT/PTO

11 9 JAN 2001

PTO/SB/92 (08-00)

Approved for use through 10/31/2002. OMB 0651-0031

U.S. Patent and Trademark Office: U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it contains a valid OMB control number.

#3 \$

## Certificate of Mailing under 37 CFR 1.8

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Assistant Commissioner for Patents  
Washington, D.C. 20231

on January 16, 2001  
Date

Signature

KATHY A. COULBOURN

Type or printed name of person signing Certificate

Note: Each paper must have its own certificate of mailing, or this certificate must identify each submitted paper.

09/700,443

FA0973 US PCT

Petition Under 37 CFR 1.10(d), or in the Alternative, Under 37 CFR 1.137(b)

Attachments:

Notification of Abandonment

Express Mail Label No. EL031052691US

Daily Log Sheet for Nov. 8, 2000

Database Screen Shot

Stamped Post Card Receipt

06/07/2001 LEDUVIJE 00000102 041928 09700443

01 FC:141 1240.00 CH

Burden Hour Statement: This form is estimated to take 0.03 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.